

## **REMARKS**

### **I. Introduction**

Claims 12-22 are currently pending in the present application. Claim 15 has been amended to correct a typo, and the amendment does not affect the scope of claim 15.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

### **II. Rejection of Claims 12-14 and 22 Under 35 U.S.C. § 102**

Claims 12-14 and 22 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,016,231 (“Kanbara”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under 35 U.S.C. §102(b), a single prior art reference must identically disclose each and every claim feature. See Lindeman Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claim feature is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Furthermore, in order to rely on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). “Inherency, however, may not be established by probabilities or possibilities,” i.e., “mere possibility that a certain thing may result from a give set of circumstance is not sufficient.” In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

As an initial matter, it is unclear which reference the Examiner believes anticipates the present application. The Examiner states that “claims 12-14 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kanbara et al.” However, the Examiner then says

“Hedenetz discloses . . . ,” and continues to refer to Hedenetz, which is listed as “prior art made of record and not relied upon.” It is assumed from the discussion of the rejection, that the Examiner is relying upon Hedenetz and not Kanbara. However, this is ultimately unimportant, since neither Kanbara nor Hedenetz discloses all of the claim features of claim 12.

Claim 12 recites a feature of “if a certain variable is present, blocking at least one of the voltage detection and a relaying of the detected voltage value.” The Examiner states that “Hedenetz discloses sensing the voltage across the device at a predetermined time in synchronization with a fuel injection event of the piezoelectric element. Hedenetz also discloses the read voltage used to correct a charging or discharging of the piezoelectric element and/or for diagnosis purposes.” However, this contention by the Examiner (or any part of the disclosure of Hedenetz or Kanbara) clearly fails to suggest the claim feature of “blocking at least one the voltage detection and a relaying of the detected voltage value” if “a certain variable is present.” Thus, neither Hedenetz nor Kanbara discloses all of the claim features of claim 12.

For at least the foregoing reasons, claim 12 and its dependent claims 13 and 14, as well as claim 22 which recites features substantially similar to those of claim 12, are allowable over the prior art of record.

### **III. Rejection of Claims 15-21 Under 35 U.S.C. § 103(a)**

Claims 15-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application 2002/0008440 A1 (“Hedenetz”) in view of Examiner’s belief. Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests ***all of the claim limitations***. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

As an initial matter, the conclusory statement that “the Examiner considers that one with ordinary skill in the art would recognize at least one of the claimed functions to be necessary to compensate for the aging of the piezoelectric actuator” is clearly insufficient to meet the requirements for establishing obviousness as set forth by the Supreme Court, i.e., the Examiner’s contention is a mere conclusory statement which fails to provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In any case, claims 15-21 ultimately depend on claim 12. As explained above, the overall teaching of Hedenetz does not suggest all of the features of parent claim 12. Furthermore, the Examiner’s conclusory statement clearly does not remedy the deficiencies of Hedenetz as applied against parent claim 12. Therefore, the overall teachings of Hedenetz and the Examiner’s contentions based on the ordinary skill in the art cannot render obvious claim 12 and its dependent claims 15-21.

For at least the foregoing reasons, claims 15-21 are allowable. Withdrawal of the obviousness rejection of claims 15-21 is requested.

## CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the pending claims 12-22 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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